

Removal of Finality

During the interview, Applicants requested that the finality of the present Office Action be removed in light of the new rejection under 35 USC 103 in view of U.S. Patent No. 6,542,598, discussed below. Applicants wish to thank the Examiners for agreeing to remove the finality of the present Office Action.

Rejection Under 35 USC 103

Claims 1-24 were rejected under 35 USC 103 as being unpatentable over Shukuzaki et al. (U.S. Patent No. 5,266,321) in view of Sunkel et al. (U.S. Patent No. 6,542,598). See Page 3-4 of the Office Action. Applicants respectfully disagree.

As discussed in the prior amendment, filed on January 3, 2003, Shukuzaki et al. is silent with respect to mascara, which is applied to eyelashes and eyebrows. Rather, Shukuzaki et al. relates to cosmetics that are applied to the skin. See col. 1, line 68 through col. 2, line 3 of Shukuzaki et al., which states “the inventors have found that an oil make-up cosmetic which is less sticky and provides a fresh, smooth feeling to the skin but also superior make-up effects. (emphasis added).” Thus, the compositions of Shukuzaki et al. actually teaches away from mascaras, which require stickiness in order to help the compositions adhere to the hairs. Thus, one of ordinary skill in the art would not have been suggested to manufacture mascara by the teachings of Shukuzaki et al.

According to the Office Action, “Sunkel teaches cosmetic compositions comprising siloxane elastomers wherein the composition may be in the form of a foundation, mascara, eye shadows, powders, blushers, lip color, and the like Therefore, it would have been obvious to one of ordinary skill in the pharmaceutical art at the time the invention was made to use the teachings of Sunkel within the teachings of Shukuzaki because Sunkel explicitly teaches cosmetic compositions comprising organosiloxane elastomers” See pages 3-4 of the Office Action.

While Sunkel et al. does disclose the use of silicone elastomers in mascara (see Example II of Sunkel et al. at cols. 23-24), Sunkel et al. does not disclose, nor suggest, a mascara that “comprises less than about 1%, by weight, of wax,” as set forth in independent claim 1 of the present application. The mascara set forth in Example II of Sunkel et al. comprises 3%, by weight, of carnauba wax, 3.75%, by weight, of white beeswax, 2.25%, by weight, of paraffin

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wax 118/125, and 2.25%, by weight, of paraffin wax. Thus, Sunkel et al. does not teach, nor suggest, the mascara recited in independent claim 1 of the present application, which "comprises less than about 1%, by weight, of wax."

Accordingly, Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn.

Submission of Translation

During the interview, it was discovered that the Applicants had failed to submit a translation of European Patent Application No. 1,066,814, which was submitted in an IDS on February 21, 2003. Applicants again wish to apologize for this oversight, and intend to submit such a translation shortly.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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